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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,952	08/09/2001	Charlton Clinton Tooke III	11963-002001	2009
26171	7590	08/24/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/924,952	TOOKE, CHARLTON CLINTON	
	<b>Examiner</b>	<b>Art Unit</b>	
	Natalie A. Pass	3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11,13-33 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,13-33 and 35-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 12 June 2006. Claims 1, 13, 17, 26, 41-42 have been amended. Claims 12 and 34 have been cancelled. Claims 1-11, 13-33, 35-42 remain pending.

### ***Duplicate Claims Warning***

2. The duplicate claims warning is hereby withdrawn due to the response filed 12 June 2006.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-11, 13, 18, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deavers, U.S. Patent Number 6, 044, 352 for substantially the same reasons given in the previous Office Action (paper number 01092005), and further in view of Kenna, et al., U.S. Patent Number 6,108,641. Further reasons appear hereinbelow.

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(A) Claim 1 has been amended to recite the limitations

- "opening a health savings account, comprising a nontaxable section and a taxable section, wherein the taxable section of the health savings account is placed in an investment vehicle," in lines 3-4;
- "before the health care consumer is obligated to pay tax on the resources," in lines 6-7;
- "such that resources inserted into the taxable section are taxed," in lines 8-9;
- "enabling the health care consumer to withdraw resources from the taxable section at will," in line 10;
- "accessing setting preferences for the health savings account that determine the manner in which the resources are withdrawn from the taxable section and the nontaxable section of the health savings account, the setting preferences affecting the transition of withdrawals between the taxable section and the nontaxable section," in lines 11-14; and
- "using the setting preferences to allocate resources," in line 16.

As per these newly added limitations, Deavers teaches a method as analyzed and discussed in the previous Office Action (paper number 01092005), further comprising

opening a health savings account, comprising a nontaxable section and a taxable section, (Deavers; column 2, lines 51-56, column 3, lines 48-56, column 16, lines 17-21);

enabling the health care consumer to insert resources into the nontaxable section of the health savings account before the health care consumer is obligated to pay tax on the resources (Deavers; column 4, lines 39-51, 59-67, column 10, lines 20-37);

enabling the health care consumer to insert resources into the taxable section of the health savings account such that resources inserted into the taxable section are taxed (Deavers; column 10, lines 20-37);

enabling the health care consumer to withdraw resources from the taxable section at will (Deavers; column 3, lines 7-20).

Deavers fails to explicitly disclose

wherein the taxable section of the health savings account is placed in an investment vehicle;

accessing setting preferences for the health savings account that determine the manner in which the resources are withdrawn from the taxable section and the nontaxable section of the health savings account, the setting preferences affecting the transition of withdrawals between the taxable section and the nontaxable section; and

using the setting preferences to allocate resources.

However, the above features are well-known in the art, as evidenced by Kenna.

In particular, Kenna teaches

wherein the taxable section of the health savings account is placed in an investment vehicle (Kenna; column 13, lines 44-51);

accessing setting preferences for the health savings account that determine the manner in which the resources are withdrawn from the taxable section and the nontaxable section of the health savings account, the setting preferences affecting the transition of withdrawals between the taxable section and the nontaxable section (Kenna; Figure 2, column 5, lines 33-39); and

using the setting preferences to allocate resources (Kenna; Figure 2, column 5, lines 33-39).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Deavers to include the above limitations, as taught by Kenna, with the motivations of implementing the MSA (medical savings account) concept by enabling “fluid interaction” and “exchange of timely electronic information” (Kenna; column 3, lines 14-26).

(B) Amended claim 13 differs from method claim 1 in that it recites a health savings account for a health care consumer, rather than a method for managing health care resources for a health care consumer, in the preamble.

Apparatus claim 13 repeats the subject matter of claim 1 as a set of elements rather than a series of steps. As the underlying processes of claims 1 have been shown to be fully disclosed by the combined teachings of Deavers and Kenna in the above rejection of claim 1, it is readily apparent that the system disclosed by Deavers and Kenna includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

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(C) Claims 4-11, 18 and 20-22 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 01092005, section 4, pages 3-5), and incorporated herein.

5. Claim 26-27, 29, 31-33, 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al., U.S. Patent Number 4,858,121 for substantially the same reasons given in the previous Office Action (paper number 01092005), and further in view of Deavers, U.S. Patent Number 6, 044, 352 and Kenna, et al., U.S. Patent Number 6,108,641. Further reasons appear hereinbelow.

(A) Amended claim 26 differs from claim 1 in that it is a health care system rather than a method of managing health care resources for a health care consumer.

As per amended claim 26, Barber teaches the “first host” and “second host” as recited the previous Office Action (paper number 01092005). However Barber fails to explicitly disclose the remainder of claim 26.

However the remainder of claim 26 repeats the subject matter of claim 1 as a set of elements rather than a series of steps. As the underlying processes of claims 1 have been shown to be fully disclosed by the teachings of Deavers and Kenna in the above rejection of claim 1, it is readily apparent that the system disclosed by Deavers and Kenna includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Barber to include the above limitations, as taught by Deavers and Kenna, with the motivations of implementing the MSA (medical savings account) concept by enabling "fluid interaction" and "exchange of timely electronic information" (Kenna; column 3, lines 14-26).

The motivations for combining the respective teachings of Deavers and Kenna are as given in the rejection of claim 1 above, and incorporated herein.

(B) Claims 27, 29, 31-33, 35-40 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 01092005, sections 6, 11, pages 6-7, 11-13), and incorporated herein.

(D) Claim 41 has been amended to recite the limitations

- "a logical partition on a larger pooled account for multiple users," in lines 2-3.

As per this newly added limitation, Barber, Deavers and Kenna teach a system further comprising a logical partition on a larger pooled account for multiple users (Deavers; column 8, lines 47-52, column 3, lines 44-48, column 4, lines 3-14).

The motivations for combining the respective teachings of Barber, Deavers and Kenna are as given in the rejection of claims 1 and 26 above, and incorporated herein.

(E) Claim 42 has been amended to recite the limitations



- "a separate and distinct financial instrument from accounts of other users," in lines 2-3.

As per this newly added limitation, Barber, Deavers and Kenna teach a system further comprising a separate and distinct financial instrument from accounts of other users (Deavers; column 4, lines 59-62).

The motivations for combining the respective teachings of Barber, Deavers and Kenna are as given in the rejection of claims 1 and 26 above, and incorporated herein.

6. Claims 2-3, 14-17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deavers, U.S. Patent Number 6, 044, 352 and Kenna, et al., U.S. Patent Number 6,108,641, as applied to claims 1 and 13 above, and further in view of Barber et al., U.S. Patent Number 4,858,121 for substantially the same reasons given in the previous Office Action (paper number 01092005). Further reasons appear hereinbelow.

(A) Claims 2-3, 14-16, 19 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 01092005, section 8, pages 7-9), and incorporated herein.

(B) As per the amendment to claim 17 this appears to have been made merely to correct errors in the claim language. While this change renders the language of the claim smoother and more consistent, it otherwise affects neither the scope and breadth of the claim as

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originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 01092005, section 8, page 9), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

7. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deavers, U.S. Patent Number 6, 044, 352 and Kenna, et al., U.S. Patent Number 6,108,641, as applied to claims 13 and 20 above, and further in view of Henley, U.S. Patent Application Publication Number 2002/0065758 for substantially the same reasons given in the previous Office Action (paper number 01092005). Further reasons appear hereinbelow.

(A) Claims 23-25 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 01092005, section 9, pages 9-10), and incorporated herein.

8. Claims 28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al., U.S. Patent Number 4,858,121, Deavers, U.S. Patent Number 6, 044, 352 and Kenna, et al., U.S. Patent Number 6,108,641 as applied to claim 26 above, and further in view of Henley, U.S. Patent Application Publication Number 2002/0065758 for substantially the same reasons given in the previous Office Action (paper number 01092005). Further reasons appear hereinbelow.

(A) Claims 28, 30 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 01092005, section 10, pages 10-11), and incorporated herein.

***Response to Arguments***

9. Applicant's arguments filed 12 June 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 12 June 2006.

(A) At page 9 of the 12 June 2006 response, Applicant appears to have inadvertently listed incorrect cancelled claims, amended claims, and Examiners. Examiner notes that it was claim 34, and not claim 36, that was cancelled, and that claim 17 should have been listed as one of the amended claims. In addition, Examiner notes that the participants in the June 7, 2006 interview were Examiners Pass and Thomas, and not Pass and Ross.

(B) Applicant's arguments on pages 9-11 of the response filed 12 June 2006 with respect to claims 1-11, 13-33, 35-42 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:** (571) 273-8300.

For formal communications, please mark  
"EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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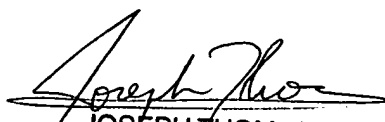
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

August 17, 2006



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER